

**REMARKS**

Claims 27-38 and 40-61 are pending in this application. Claims 36-38, 40-48 and 51 were allowed. Claims 27-35, 49, 50, 52-54 and 56-60 were rejected. Claims 55 and 61 were objected.

Claim 49 has been amended. No new matter has been added.

**I. Claim Rejections - 35 U.S.C. §112**

Claims 49 and 50 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 49 has been amended: "said third aroma" has been changed to "said second aroma."

The examiner stated that claims 49-50 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in the final Office action and to include all of the limitations of the base claim and any intervening claims.

Therefore, allowance of claims 49 and 50 are respectfully requested.

**II. Claim Rejections - 35 U.S.C. §103**

Claims 27-30, 32-35, and 52-54 stand rejected under 35 U.S.C. 103(a) as being unpatentable over MacLean (U.S. Patent No. 5,771,778) in view of Watkins (U.S. Patent No. 5,591,409).

Claims 31 and 56-60 rejected under 35 U.S.C. 103(a) as being unpatentable over MacLean '778, in view of Watkins '409, as applied above, and further in view of Burns (U.S. Patent No. 5,062,272).

**1. Claims 27-35, 52-54 and 56-60: The combination of the references**

When the incentive to combine the teachings of the references is not readily apparent, it is the duty of the examiner to explain why combination of the reference teachings is proper. Ex parte Skinner, 2 USPQ2d 1788, 1790 (Bd. App. & Int’f 1986).

The examiner asserted that it would have been obvious to one of ordinary skill in the art to incorporate the aroma mixing, passageways and nozzles of Watkins ‘409 into the invention of MacLean IV (1-1) since both are directed to aroma generating methods, (1-2) since MacLean IV already teaches the use of a “solenoid which periodically acts to depress the nozzle/actuator of an aerosol can and plural aroma source in the form of unpopped popcorn kernels, (1-3) since the plural aroma sources and nozzles of Watkins ‘409 are in the form of aerosol cans with nozzles which are depressed by solenoids, and (1-4) since mixing of aroma would have provided more accurate aromas as well as a greater variety of aromas which would have been more appealing to the consumer.”

The examiner also asserted that it would have been obvious to one of ordinary skill in the art to place the aroma sources of MacLean IV in the parts chamber, in view of Watkins ‘409, (2-1) since both are directed to aroma generating methods, (2-2) since MacLean IV already teaches a parts chamber, and (2-3) since placing the aroma source in the parts chamber, away from the cooking chamber, would have prevented the overheating and possible explosion of the aerosol cans used by MacLean IV while still providing the necessary aromas.

The examiner’s assertion was not proper because the prior art does not suggest the desirability of the claimed invention and the examiner’s conclusion was based on the impermissible hindsight reasoning.

(1) “The mere fact that it is possible to find two isolated disclosures which might be combined in such a way to produce a new compound does not necessarily render such production obvious unless the art also contains something to suggest the desirability of the proposed combination.” (*In re Bergel*, 292 F.2d 955, 956-57, 130 USPQ 206, 208 (CCPA 1961))

Accordingly, the examiner’s arguments of (1-1), (1-2) (1-3), (2-1), and (2-2) were not relevant to the desirability of the claimed invention. At most the arguments of (1-4) and (2-3) may be relevant, but not enough to show the desirability.

MacLean ‘778 relates to a marketing system. For example, the machine can sell a popcorn. The aroma of the popcorn draws shoppers (col. 8, lines 25-26). Also, “[m]ore particularly, the housing 12 includes a window, such as a glass or clear window 50 in the door 14. In the illustrated embodiment, the popping chamber 48 is formed of clear Pyrex (™). This allows a visual display of popcorn being popped, which captivates passers by while an advertisement is displayed on the display 42.” (Column 8, lines 29 to 35)

The examiner asserted that MacLean ‘778 teaches a parts chamber (Fig. 2, 42), and that it is obvious to one of ordinary skill in the art to place the aroma sources of MacLean ‘778 in the parts chamber.

The parts chamber (Fig. 2, 42) in MacLean ‘778 is a display. Also, the display includes an LED or LCD display, a video monitor, or a 13 inch Sony Trinitron monitor. (Col. 7, lines 38 to 44). Placing the aroma sources in this display or replacing this display with the parts chamber of Watkins ‘409 is neither desirable nor obvious. Also, it is unnecessary to include the structures and the steps

of Watkins '409 in the marketing system of MacLean '778. Particularly, the examiner asserted that placing the aroma source in the parts chamber, away from the cooking chamber, would have prevented the overheating and possible explosion of the aerosol cans used by MacLean '778 while still providing the necessary aromas. If the examiner's explanation is correct, why should the aroma source be placed in the display of MacLean '778? Is it safer to place the aroma sources in the bottom of the machine rather than in the display having electronics? That is, the examiner simply engaged in a hindsight reconstruction of the claimed invention, using the present invention as a template, and picking and choosing elements from references *to fill the gaps*. ("As in all determination under 35 U.S.C. §103, the decision-maker must bring judgment to bear. **It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements from references to fill the gaps.**" In re Gorman, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991); "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." In re Fritch, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992));

Specifically, in Al-Site Corp., the court held that the level of skill in the art cannot be relied upon to provide the suggestion to combine references. Al-Site Corp. v. VSI Int'l Inc., 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999); In Al-Site Corp., the defendant relied on what it presumes is the level of knowledge of one of ordinary skill in the art at the time of the invention to supply the missing suggestion to combine. The court held that:

"[i]n the first place, the level of skill in the art is a prism or lens through which a judge or jury views the prior art and the claimed invention. This reference point prevents these

deciders from using their own insight or, worse yet, to gauge obviousness. **Rarely, however, will the skill in the art component operate to supply missing knowledge or prior art to reach an obviousness judgment.** See W.L. Gore & Assocs., Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983) (“To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.”. Skill in the art does not act as a bridge over gaps in substantive presentation of an obviousness case, but instead supplies the primary guarantee of objectivity in the process. See Ryko Mfg. Co. v. Nu-Star, Inc., 950 F.2d 714, 718, 21 USPQ2d 1053, 1057 (Fed. Cir. 1991).” Al-Site Corp. v. VSI Int’l Inc., 174 F.3d 1308.

(2) If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)

Here, as a marketing system, when it sells popcorn, not only the aroma of the popcorn itself but also the visual display in the popping chamber of popcorn being popped is important for drawing the passing customers. Accordingly, it is not desirable to replace the display with the parts chamber of Watkins ‘409. Also, the examiner stated in the office action that “how could aroma more directly “correspond” to a food, than to have that food’s natural aroma” (page 6, lines 3-4 on the final Office action). That is, the examiner implicitly admitted that it is not desirable to have the aroma selection

*What?*

and mixing step when a natural food's aroma is generated while the food is being cooked. Also, the examiner stated that MacLean '778 does not disclose the aroma selection, but Watkins '409 discloses the aroma selection. Why is the additional step of selecting the aroma corresponding to the food to be cooked needed when the aroma food itself is more efficient to attract customers? Or why is the additional structure of Watkins '409 needed in the marketing machine if the food itself generates the aroma? The examiner cannot argue that when nonaroma food is selected, the aroma selection and the aroma mixing are needed. The purpose of the marketing machine in MacLean '778 is for attracting passing customers. After the payment was made, the marketing machine does not have to have an additional step and equipment of selecting an aroma and mixing an aroma corresponding to the food selected by the customer. Since it is not proper under 35 U.S.C. 103 to modify a prior art in a manner which would destroy that aspect on which the invention of the prior art patent was based. Ex parte Hartman, 186 USPQ 366, 367 (PTO Bd. App. 1974).

Accordingly, the examiner's conclusion of obviousness is based on improper hindsight reasoning.

Therefore, allowance of all of the pending claims is respectfully requested.

## **2. For attacking the reasoning, not the references individually.**

The examiner stated that "in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.

The examiner should be noted that the burden of showing a prima facie case of obviousness

is on the examiner. The examiner must show that the prior art reference (or references when combined) teaches or suggests all the claim limitations. See the MPEP 706.02(j) and 2143 and 35 U.S.C. §103. In re Royka, 490 F.2d 981 (CCPA 1974). If the examiner's showing is not proper, the applicant may traverse the rejection based on the examiner's reasoning.

For example, if the examiner asserted that the element "A" is in the prior art "X", and the element "B" is in the prior art "Y", the applicant cannot argue that the prior art "X" does not disclose the element "B" by attacking references individually. However, the applicant may traverse the examiner's prima facie case of obviousness by showing that the element "A" is not in the prior art "X." In this case, the attacking is for the examiner's reasoning, not for attacking references individually. If the applicant shows that the examiner fails to establish a prima facie case, the rejection is improper and will be overturned. In re Fine, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988)

### **3. With respect to claim 27**

**First**, there is neither incentive nor motivation to combine the references for the foregoing reason.

**Second**, the rejection on claim 27 is improper since the examiner fails to establish a prima facie case because all the claim limitations are not taught or suggested by the prior art.

To establish a *prima facie* case of obviousness, for a rejection of claims under 35 U.S.C. §103, three basic criteria must be met. One of them is that the prior art reference (or references when combined) must teach or suggest all the claim limitations. See the MPEP 706.02(j) and 2143 and 35 U.S.C. §103. In re Royka, 490 F.2d 981 (CCPA 1974)). "All words in a claim must be considered

in judging the patentability of that claim against the prior art." In re Wilson, 424 F.2d 1382, 1385 (CCPA 1970).

Here, the examiner asserted that the step of making a selection of a cooking menu is disclosed at column 9, lines 11-20 on MacLean '778, the step of generating said aroma from at least one aroma source selected from said plurality of aroma source is disclosed at column 8, line 25 on MacLean '778, and that Watkins '409 teaches a method of providing aromas comprising plural aroma storage units and mixing of the aromas, providing the aroma storage unit in the parts chamber with passageways out of the parts chamber, and multiple nozzles.

Even if the combination were made, the claimed invention would still not be taught.

The combination at most teaches the selection of a food to be cooked among the plurality of stored foods to be cooked, and the step of selecting an aroma, but not the step of selecting an aroma corresponding to the food to be cooked. Since claim 27 explicitly claims the step of selecting an aroma corresponding to said food and this step is an active step, this aroma selection step should not be regarded as the step of selection of food to be cooked. The unpopped popcorn kernel is a food to be cooked, and thus, the examiner's recitation is at most the step of selecting a food among the stored plurality of foods (e.g., unpopped popcorn kernel) to be cooked. If nonaroma food is selected in MacLean '778 combined with Watkins '409, the aroma selection corresponding to the food to be cooked is not taught. That is, the step of selecting an aroma corresponding to the food to be cooked should not be regarded as the step of selecting a food itself to be cooked. The disclosure at column 9, line 24+ shows the aroma generated by the few sacrificial kernels. This sacrificial kernels are not the food to be cooked, and the aroma generated by the sacrificial kernels may be regarded as the

aroma generated by the aroma source, not by the food itself, because the popcorn generated by sacrificial kernels are grinded. However, these sacrificial kernels are not selected in accordance with the food to be cooked because the sacrificial kernels are produced to attract passing shoppers.

Therefore, the examiner fails to establish a prima facie case of obviousness.

**Third**, the claimed invention "as a whole" is not obvious.

"In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); Schenck v. Nortron Corp., 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983) (See MPEP §2141.02)

"[A] patentable invention may lie in the discovery of the source of a problem even though the remedy may be obvious once the source of the problem is identified. This is part of the 'subject matter as a whole' which should always be considered in determining the obviousness of an invention under 35 U.S.C. § 103." In re Sponnoble, 405 F.2d 578, 585, 160 USPQ 237, 243 (CCPA 1969).

The present specification clearly states one of the purposes of the present invention: "an aroma generating device for diffusing a variety of aromas corresponding to a selected food in order to stimulate the user's appetite while the user is waiting the food cooked." (Page 3, lines 2 to 3)

The purpose and its solution in the present application are not recognized in the prior art. At most, MacLean '778 recognizes the necessity of aroma in the marketing machined for attracting

passing shoppers.

Therefore, the claimed invention as a whole is not obvious.

Reconsideration of rejection of claim 27 is respectfully requested.

#### **4. With respect to claims 28-30 and 32 to 35**

**First**, claims 28-30 and 32-35 depend from claim 27 so that these dependent claims include the limitations of claim 27. Since the applicant has presented above reasons why independent claim 27 is patentable, claims 28-30 and 32-35 are also patentable.

**Second**, the rejection is improper since the examiner fails to establish a prima facie case because all the claim limitations are not taught or suggested by the prior art.

In rejecting claims 28-30 and 32, the examiner further states that the step of diffusing the aroma before cooking is disclosed at column 9, line 25, the step of intermittent diffusion at column 9, lines 25-28, and the terminating diffusion after cooking by grinding the unused popcorn at column 9, line 29-31 on MacLean '778.

The disclosure in column 9, lines 25 to 31 on MacLean '778 discloses that a few kernels are periodically popped, regardless of whether payment has been inserted in the payment receptacle. That is, this disclosed step is made without the step of making a selection of a cooking menu for cooking food and irrespective of the selection of the food to be cooked. Because it is not possible to know which food is to be cooked without the step of selecting food to be cooked, the aroma recited in the disclosure at column 9, lines 25 is not the aroma corresponding to the food to be cooked. On the other hand, the step in claim 28 of the present application claims diffusing said

aroma "corresponding to said food" to be cooked before said food is cooked.

In rejecting these claims, the examiner picks the aroma which is different from the aroma recited in rejecting claim 27, while the aromas in claims 27 and 28 of the present invention are claimed as the same. In other words, the examiner simply engaged in a hindsight reconstruction of the claimed invention, using the present invention as a template, and picking and choosing elements from references to fill the gaps.

Therefore, withdrawal of the rejection is respectfully requested.

#### **5. With respect to claim 52**

**First**, there is neither incentive nor motivation to combine the references for the foregoing reason.

**Second**, the rejection on claim 52 is improper for the same reasonings stated in the above response regarding claim 27. That is, even if the combination were made, the claimed invention would still not be taught.

Supplemental to the above reasoning, the disclosure at column 8, line 25 in MacLean '778 teaches at most the generation of the aroma by cooking only aroma food itself, but, even when combined with Watkins '409, does not teach the step of controlling an aroma generator according to the selected cooking menu to select the aroma corresponding to the selected cooking menu. If aroma food is selected in MacLean '778 combined with Watkins '409, there is no step of controlling an aroma generator according to said cooking menu to select an aroma corresponding to the cooking menu because the aroma is generated from the food being cooked. Furthermore, if nonaroma food

is selected in MacLean '778 combined with Watkins '409, the step of controlling an aroma generator according to said cooking menu to select an aroma corresponding to the cooking menu is not taught or suggested.

Reconsideration of rejection of claim 52 is respectfully requested.

**6. With respect to claims 53 and 54**

Claims 53-60 depend from claim 52 so that claims 53-60 include the limitations of claim 52. Since the applicant has presented above reasons why independent claim 52 is patentable, claims 53-60 are also patentable.

**7. Claims 31, 56-60**

Claims 31 and 56-60 stand rejected under 35 U.S.C. 103(a) as being unpatentable over MacLean '778, in view of Watkins '409, as applied above, and further in view of Burns (U.S. Pat. No. 5,062,272).

**First**, reconsideration of the rejection of claims 31 and 56-60 is also respectfully requested because applicant has presented above reasons why claims 27, 30 and 52 are patentable and claims 31 and 56-60 depend effectively from claims 27, 30 and/or 52.

**Second**, at least Burns '272 is nonanalogous art.

The Court of Appeals for the Federal Circuit (CAFC) has developed a two-step for determining whether particular references are within the appropriate scope of the inventor's art, i.e.,

whether the references relate to analogous art. In re Deminski, 230 USPQ 313 (Fed. Cir. 1986); In re Clay, 23 USPQ2d 1058 (Fed. Cir. 1992) See MPEP 2141.01(a). In applying the two-step test, it must first be determined whether the prior art reference is within the field of the inventor's endeavor. Second, if the reference is not within the inventor's field of endeavor, then it must be determined whether or not the reference is reasonably pertinent to the inventor's particular solution to a problem. A reference that fails both parts of the test cannot properly be used to support an obviousness rejection under 35 U.S.C. 103.

Here, it is clear that Burns '272 is not within the cooking apparatus field.

In addition, the present specification clearly states one of the purposes of the present invention: "an aroma generating device for diffusing a variety of aromas corresponding to a selected food in order to stimulate the user's appetite while the user is waiting the food cooked." (Page 3, lines 2 to 3). On the other hand, Burns '272 is for overcoming possibly noxious or stale food odors that may be coming from a refrigerator or freezer. It cannot be said that Burns '272 is reasonably pertinent to the purpose or solution of the present invention only because Burns '272 includes the deodorizing step.

Therefore, Burns '272 is not within the appropriate scope of the inventor's art.

**Third**, even if Burns '272 is analogous art, there is no suggestion or motivation to make the proposed modification.

If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed

modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)

The examiner asserted that, it would have been obvious to one of ordinary skill in the art to deodorizing and scent replacement of Burns'272 into the invention of MacLean '778 since both are directed to aroma generating methods, and since consumers have different tastes and preferences for aromas and their interest can be increased by substituting a more pleasing aroma for the original.

The examiner asserted that it would have been obvious to one of ordinary skill in the art to incorporate deodorizing and scent replacement of Burns'272 into the invention of MacLean '778 since both are directed to aroma generating methods, since MacLean '778 already included the production and dispersion of scents (column 4, lines 55-68), and since consumers have different tastes and preferences for aromas and their interest can be increased by substituting a more pleasing aroma for the original.

The examiner's rejection is based on improper hindsight construction.

MacLean '778 relates to a marketing system, and clearly states that "[t]he aroma of popcorn draws shoppers to lower traffic areas of a retail establishment" (column 25-27), and that "[t]he few sacrificial kernels are sufficient to produce the aroma of popcorn to attract passing shoppers" (column n 9, lines 28). The examiner should be noted that the purpose of the marketing machine of MacLean '778 is to promote the sales of the products in the marketing machine.

If the user selects a popcorn, why does the machine deodorize the popcorn aroma (*i.e.*, "a food aroma produced from the food cooked" in claim 31), which can attract passing customers? Also, where the machine cannot know the next customer's taste and preference, why does the marketing machine deodorize the aroma which has been already generated and still attracts the

customers? Conclusively, the ordinary skilled person in the art will not install the deodorizer in the marketing machine.

Therefore, the examiner simply engaged in a hindsight reconstruction of the claimed invention. There is no desirability of the modification asserted by the examiner.

**8. With respect to Claims 55 and 61**

The examiner stated that claims 55 and 61 were objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Reconsideration of the rejection of claims 55 and 61 is also respectfully requested because applicant has presented above reasons why claims 54 and 60 are patentable, and claims 55 and 61 depend effectively from claim 54 or 60.

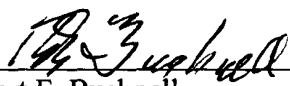
In view of the above, all claims are deemed to be allowable and this application is believed to be in condition to be passed to issue. Should any questions remain unresolved, the Examiner is requested to telephone Applicant's attorney.

No fee is incurred by this Amendment.

Should a Petition for extension of time be required with the filing of this Amendment, the Commissioner is kindly requested to treat this paragraph as such a request and is authorized to

charge Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of the incurred fee if a check of the requisite amount is not enclosed.

Respectfully submitted,

  
Robert E. Bushnell,  
Attorney for the Applicant  
Registration No.: 27,774

1522 "K" Street N.W., Suite 300  
Washington, D.C. 20005  
(202) 408-9040

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